

REMARKS

The foregoing response does not include the introduction of new matter into the present application for invention. Therefore, the Applicant, respectfully, requests that the present application for invention, kindly, reconsidered in view of the following remarks.

The Office Action dated December 4, 2003 has been received and considered by the Applicants. Claims 10-42 are pending in the present application for invention. Claims 10-19, 22, 23, 25, 27, 29, 31, 33, and 35 stand rejected and Claims 20, 21, 24, 26, 28, 30, 32, 34, and 36-42 are objected to by the December 4, 2003 Office Action.

The Office Action rejects Claims 10-24, 31, 32, 35, 36, 40, and 42 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 22-34 of U.S. Patent No. 6,370,090. The Examiner states that although the conflicting claims are not identical, they are not patentably distinct from each other.

The Applicant, respectfully, requests that the rejection of Claims 10-24, 31, 32, 35, 36, 40, and 42 under the judicially created doctrine of obviousness-type double patenting be rescinded for the following reason. U.S. Patent No. 6,370,090 is the parent case of the present invention and as such the claims of U.S. Patent No. 6,370,090 can be used as a basis for a double patenting rejection, but these claims cannot be treated as prior art. In making the aforementioned obvious-type double patenting rejection, the Examiner inherently states that the rejected claims to the present invention differ from that of that of U.S. Patent No. 6,370,090 (the parent case) because, simply put, a same-invention, double patenting rejection has not been made. The Final Office Action alleges that the claims to the present invention are obvious in view of the claims to U.S. Patent No. 6,370,090, however, the Examiner has cited no prior art, whatsoever, showing that the differences between the rejected claims of the present invention and the claims to U.S. Patent No. 6,370,090 amount to an obvious modification of the claims to U.S. Patent No. 6,370,090. Without a prior art recitation to substantiate an obvious-type double patenting rejection, there is no factual basis upon which the assertion of obviousness can be measured. Therefore, the double patenting rejection cannot stand. The foregoing analysis is clearly the rule regarding obvious type double patenting rejections and is a synopsis from a decision before the Board of Patent Appeals And Interferences, Appeal No. 1998-0425, Ex parte Frank L. Schmit, Lloyd Ewing and David T. Redmon, Application No. 08/272,527, pages 4-5.

Accordingly, the rejection of Claims 10-24, 31, 32, 35, 36, 40, and 42 under the judicially

created doctrine of obviousness-type double patenting as being unpatentable over Claims 22-34 of U.S. Patent No. 6,370,090, is respectfully, traversed.

The Office Action rejects Claims 10-19, 22, 23, 25, 27, 29, 31, 33, and 35 under the provisions of 35 U.S.C. §103(a), as being unpatentable over U.S. Patent No. 5,384,678 issued to Nishida et al. (hereinafter referred to as Nishida et al.) in view of U.S. Patent No. 5,592,450, issued to Yonemitsu et al. (hereinafter referred to as Yonemitsu et al.).

The Examiner states that Nishida et al. teaches the aspects of rejected Claim 10 except for providing of an additional mutually logically conforming sub-TOC for the same track area in one or more track areas of a unitary storage medium and the additional sub-TOC having structures for storing information for determining the configuration of the same information items stored in the track area, thereby allowing retrieving the configuration of the same information item in the track area from at least any correct copy of the sub-TOCs.

The Examiner states that Yonemitsu et al. in Fig. 5 teaches a recording medium providing additionally mutually logically conforming TOCs in a unitary storage medium, wherein, the additional TOCs at structures for storing information for determining the configuration of the same information items stored in the track area, thereby allowing retrieving the configuration of the same information item in the track area from at least any correct copy of the TOCs. The Applicants would like to draw the Examiner's attention to column 11, line 56 through column 12, line 4 of Yonemitsu et al. wherein Fig. 5 is discussed. The Applicants would like to, respectfully, point out that Yonemitsu et al. discusses a TOC being placed within the lead in area and the copy of the TOC being placed in the program area. The lead in area as discussed by Yonemitsu et al. on column 11, lines 34-55 is a separate area of the disc from the program area. The sector address of the first track of the program area is identified as address 0. In Fig. 5, Yonemitsu et al. illustrates the TOC data located within the lead in area and a copy of the TOC data being located within the program area, however, there is no discussion within Yonemitsu et al. for placing redundant copies of the TOC data within the same track. Moreover, there is no disclosure, or suggestion, within Yonemitsu et al. for placing sub-TOC data for storing information for determining the configuration of the same information items stored in the track area as recited by rejected claim 10. Therefore, there are features that are recited by rejected claim 10 that are not found within the combination made by the Examiner.

In an attempt to cure this defect, the Examiner states that since Yonemitsu et al. teaches

that it is advantageous to make a duplicate copy of the TOC file, and that Nishida et al. teaches a master TOC that refers to a sub-TOC within a chapter, that it would have been obvious for personal skill the art to create the storage medium defined by the method steps of rejected claim 10 to the present invention. The Applicants, respectfully, disagree. The combination of Yonemitsu et al. with Nishida et al. made in the Final Office Action would logically result a master TOC in the entry level of the disc with a copy of the master TOC somewhere in the program area and at most a single sub-TOC in each discrete part of the program area. Rejected claim 10 recites the elements of providing at least two mutually logically conforming sub-TOCs for the same track area in one or more track areas of a unitary storage medium, and providing at least one master-TOC having structures for storing information for determining the position of the sub-TOCs. There is no disclosure, or suggestion, in either Yonemitsu et al. or Nishida et al. for placing a redundant sub-TOC in a single track as recited by rejected Claim 10 to the present invention. Therefore, there are features within rejected Claim 10 that are not found the combination made by the Final Office Action.

As stated in the MPEP at §2142, “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).”

Regarding the first point above, that there must be some suggestion or motivation, to make the combination provided by the prior art, the Applicants would like to, respectfully, point out that the Final Office Action does not provide any suggestion or motivation within the cited prior art references to make the combination made in the Final Office Action. The Examiner has employed a hindsight approach using the Applicants’ disclosure as a blueprint to pick and choose the recited elements of the rejected claims from the cited prior art references. It is evident from the Final Office Action that such a hindsight approach is being employed because the Examiner is using the Applicants’ disclosure. As an example, the Examiner states that it would have been obvious for one of ordinary skill to make an additional chapter TOC file as taught by Nishida et

al. within the track similar to Yonemitsu et al. because the extra TOC information in the same track can protect information stored in the TOC file from not being read properly. This is the motivation that is provided by the Applicants' disclosure and not the cited references. The Applicants would like to, once again, draw the Examiner's attention to column 11, line 56 through column 12, line 4 of Yonemitsu et al. wherein Fig. 5 is discussed. The rationale for providing a redundant master TOC by Yonemitsu et al. is because some computer applications do not easily recognize data recorded in sectors having negative addresses. This teaching of Yonemitsu et al. suggests creating redundant files in the lead in area and the program area, not creating redundant files in the same track as recited by rejected Claim 10. There is no suggestion provided by Yonemitsu et al. for creating redundant files within the same track. The specification to the present application for invention on page 8, lines 22-26 provides the motivation for creating redundant files within the same track to overcome interference through environmental and other influences. Nishida et al. provides no redundancy at all.

Regarding the second point above, a reasonable expectation of success must be found in the prior art, and not based on Applicants' disclosure. The Final Office Action has failed to provide any support that either Nishida et al. or Yonemitsu et al. had envisioned that it is possible to read a second sub-TOC in a track after a failure in attempting to read a first sub-TOC in the same track. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). In order to establish a *prima facie* case of obviousness, there must be a reasonable expectation of success found within the prior art, and there has not been any reasonable expectation of success within the prior art provided by the Final Office Action.

As previously stated, even though a hindsight approach has been employed in making the combination, there still remain recited claim elements that are not found in the combination made by The Final Office Action. The Final Office Action has not provided any prior art reference indicating a desire or usefulness of providing redundant files within the same track, much less redundant sub-TOC files within the same track. Accordingly, the rejection to Claim 10 contained within the final office action is, respectively, traversed.

The Examiner states that Nishida et al. teaches the recited elements of Claim 11. The Applicants, respectfully, disagree. Rejected Claim 11 to present invention recites storing

information items in the track area. The Applicant would like to, respectfully, point out that Nishida et al. does not have tracks. The Examiner further states that Nishida et al. discloses storing in each of the sub-TOCs structures and configuration data for each of the information items in the track area. The Applicant, respectfully, disagrees. There are, simply put, no tracks taught by Nishida et al.

Regarding Claims 12-15, these claims depend from and further narrow and define Claim 10. Therefore since Claim 10 is believed below for the above discuss reasons claims 12-15 are also believed to be allowable.

Regarding claim 16, the Examiner states that Nishida et al do not teach the features of rejected claim 16, and that Yonemitsu et al. does not specify that a copy of the TOC file can be located at the end of the track area, however, the Examiner proceeds by inserting the requisite motivation needed to modify the combination made by the Final Office Action. The Examiner's statement that for better file management and easier accessibility at the end of the track, that it would be obvious to one ordinary skill in the art to place the TOC file at the end of the track is nothing more than hindsight recreation using the Applicants' disclosure as a blueprint. Accordingly, this rejection is, respectfully, traversed.

Regarding Claims 17 and 19, Examiner states that Nishida et al. has two identical sub-TOC files as in Claims 17 and 19. The Applicants', respectfully, disagree. The Examiner is not only made a combination but has modified the combination in order to reach the elements recited by the rejected claims. As previously discussed, the Examiner must provide some rationale within the cited prior art to substantiate the combination made by the Final Office Action and the modification of the combination that the Examiner has made in order to reach the elements of rejected claims 17 and 19. There has been no such rational provided by the Final Office Action. Accordingly, this rejection is respectfully traversed.

Regarding apparatus Claims 22 and 23, the Examiner states that these claim are rejected for the reasons as Claims 10, 11 and 13. Therefore, the Applicants' traverse the rejection to Claims 22 and 23 for the same reasons as Claims 10, 11 and 13 above.

Regarding apparatus Claim 25, the Examiner states that this claim is rejected for the reasons as Claim 10, 11 and 13. Therefore, the Applicants' traverse the rejection to Claim 25 for the same reasons as Claims 10, 11 and 13 above. The Examiner further states that Claim 25 recites first control means for positioning a read head and second control means for positioning

the read head are rendered obvious by the disc drive and controller of Yonemitsu et al. The Applicants' respectfully, disagree. The Examiner has provided no support for the assertion that disc drive and controller of Yonemitsu et al. can function as different control means for positioning a read head. Accordingly, this rejection is, respectfully, traversed.

Regarding apparatus Claim 27, the Examiner states that these claim are rejected for the reasons as Claims 10, 11 and 13. Therefore, the Applicants' traverse the rejection to Claim 27 for the same reasons as Claims 10, 11 and 13 above. The Examiner further states that Claim 27 recites first control means for positioning a read head and second control means for positioning the read head are rendered obvious by the disc drive and controller of Yonemitsu et al. The Applicants' respectfully, disagree. The Examiner has provided no support for the assertion that disc drive and controller of Yonemitsu et al. can function as different control means for positioning a read head. Accordingly, this rejection is, respectfully, traversed.

Regarding apparatus Claims 29 and 33, the Examiner states that these claim are rejected for the reasons as Claims 10, 11 and 13. Therefore, the Applicants' traverse the rejection to Claims 29 and 33 for the same reasons as Claims 10, 11 and 13 above.

Regarding apparatus Claim 31, the Examiner states that these claim are rejected for the reasons as Claims 10, 11 and 13. Therefore, the Applicants' traverse the rejection to Claim 31 for the same reasons as Claims 10, 11 and 13 above.

Regarding apparatus Claim 35, the Examiner states that these claim are rejected for the reasons as Claims 10, 11 and 13. Therefore, the Applicants' traverse the rejection to Claim 35 for the same reasons as Claims 10, 11 and 13 above.

The Office Action objects to Claims 20, 21, 24, 26, 28, 30, 32, 34, and 36-42 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. As previously discussed, the base claims from which Claims 20, 21, 24, 26, 28, 30, 32, 34, and 36-42 depend are believed to be allowable over the cited references. Therefore, Claims 20, 21, 24, 26, 28, 30, 32, 34, and 36-42 which further narrow and define the base claims from which they depend are also believed to be allowable.

In an effort to move the present application for invention towards allowance, the Applicants have amended the claims to the invention.

Applicant is not aware of any additional patents, publications, or other information not

previously submitted to the Patent and Trademark Office which would be required under 37 C.F.R. 1.99.

In view of the foregoing amendment and remarks, the Applicant believes that the present application is in condition for allowance, with such allowance being, respectfully, requested.

Respectfully submitted,

By 

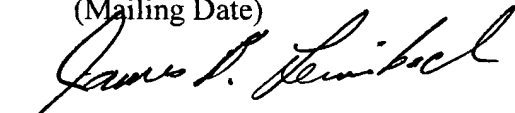
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